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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,851	01/11/2002	Brigitte Spei	H 4051 PCT/US	8297

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EXAMINER

HRUSKOCI, PETER A

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 09/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,851

Applicant(s)

SPEI ET AL.

Examiner

Peter A. Hruskoci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2003 and 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-42 is/are pending in the application.
- 4a) Of the above claim(s) 33-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups I, claims 15-32, drawn to a process.

Group II, claims 33-42, drawn to a composition.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, a special technical feature which these claims share does not define a contribution over the prior art. For example, the claims of Groups I and II share an alkoxylate of a fatty amine as the special technical feature, which is considered to lack novelty or an inventive step in view Mizuno et al. 4,656,059 (see col. 3 line 47 through col. 4 line 7).

During a telephone conversation with Stephen D. Harper on 9-2-03 a provisional election was made with traverse to prosecute the invention of Group I, claims 15-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 33-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 23-25, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. 4,656,059. Mizuno et al. disclose (see col. 2 line 40 through col. 5 line 65) a process for treating circulating water in a painting booth substantially as claimed.

The claims differ from Mizuno et al. by reciting the addition of a specific concentration of dispersant selected from a specific group of nonionic and anionic surfactants. It is submitted that the nonionic and anionic surfactants and amounts disclosed in Mizuno et al. are considered patentably indistinguishable from the recited surfactants and concentration. It would have been obvious to one skilled in the art to modify the process of Mizuno et al. by addition of the recited dispersant in the recited concentration, to aid in dispersing paint in the water. The specific surfactant and concentration utilized, and the specific mean particle size achieved, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific water treated and results desired, absent a sufficient showing of unexpected results.

Claim 19 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. 4,656,059 as above, and further in view of Gerigk et al. 5,490,939. The claims differ from Mizuno et al. by reciting an additional step of removing the paint particles from the circulating

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water by membrane filtration. Gerigk et al. disclose (see col. 5 line 26 through col. 6 line 53) that it is known in the art to utilize membrane filtration to aid in removing coating components from booth water and overspray. It would have been obvious to one skilled in the art to modify the process of Mizuno et al. by utilizing membrane filtration in view of the teachings of Gerigk et al., to aid in removing paint particles from the water.

Claims 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. 4,656,059 as above, and further in view of Zarges et al. 6,187,195. The claims differ from Mizuno et al. by reciting the addition of polyaspartic acid to the circulating water. Zarges et al. disclose (see col. 3 line 56 through col. 6 line 62) that it is known in the art to add polyaspartic acid and surfactants to industrial wastewater systems to aid in inhibiting scale formation. It would have been obvious to one skilled in the art to modify the process of Mizuno et al. by addition of polyaspartic acid in view of the teachings of Zarges et al., to aid in inhibiting scale formation in the water.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. 4,656,059 and Zarges et al. 6,187,195 as above, and further in view of Gerigk et al. 5,490,939. The claim differs from the references as applied above by reciting an additional step of removing the paint particles from the circulating water by membrane filtration. Gerigk et al. disclose (see col. 5 line 26 through col. 6 line 53) that it is known in the art to utilize membrane filtration to aid in removing coating components from booth water and overspray. It would have been obvious to one skilled in the art to modify the references as applied above by utilizing membrane filtration in view of the teachings of Gerigk et al., to aid in removing paint particles from the water.

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Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. 4,656,059 and Zarges et al. 6,187,195 as above, and further in view of Mizuno et al. 5,378,389. The claim differs from the references as applied above by reciting the addition of a dispersant selected from a group of specific homopolymers and copolymers. Mizuno et al. (389) disclose (see col. 3 line 53 through col. 6 line 23) that it is known in the art to add the recited dispersants to aid in reducing tackiness of paint in spray booth water. It would have been obvious to one skilled in the art to modify the references as applied above by addition of the recited dispersant in view of the teachings of Mizuno et al. (389) to aid in reducing the tackiness of paint particles in the water.

Claim 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. 4,656,059 as above, and further in view of Miknevich 5,730,881. The claims differ from the Mizuno et al. as applied above by reciting the addition of a dispersant selected from a group of specific oligomeric and polymeric inorganic phosphates, and organic carboxylic acids. Miknevich disclose (see col. 5 line 1 through col. 6 line 45) that it is known in the art to add the recited phosphates to aid providing corrosion protection, and recited carboxylic acids to aid in chelating hardness in paint spray booth water systems. It would have been obvious to one skilled in the art to modify the process of Mizuno et al. by addition of the recited dispersant in view of the teachings of Miknevich, to aid in reducing corrosion and in chelating hardness in the painting booth system.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is 703-308-3839. The examiner can normally be reached on Monday through Friday from 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Peter A. Hruskoci
Primary Examiner
Art Unit 1724

09/08/03